

Atty Dkt. No.: 10030636  
USSN: 10/729,606

### **REMARKS**

In view of the following remarks, the Examiner is requested to allow Claims 1-19 and 31-33, the only claims pending and under examination in this application.

In the above amendments, Claims 1, 17 and 31 have been amended to clarify the claim language. Support for these amendments can be found throughout the specification and claims as originally filed, for instance, paragraphs 62 and 63. Claims 20-30 have been withdrawn. Accordingly, no new matter has been added.

As no new matter has been added by way of these amendments, entry thereof by the Office is respectfully requested.

#### ***Claim Rejections – 35 U.S.C. § 112, first paragraph***

Claims 1-19 and 31-33 were rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not enable any person skilled in the art to which it pertains to practice the claimed invention.

According to the MPEP § 2164.01 an analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims so as to enable one skilled in the pertinent art to make and use the claimed invention. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

The Office asserts that the Applicants' specification describes the array assembly and backing elements as structural limitations of the Applicants' invention. The Office further asserts that the language of the rejected independent claims do not clearly indicate that the recited components have a "flexure" property.

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Claims 1, 17 and 31 have been amended to clarify the claim language. Claims 1, 17 and 31 now recite that the clamping member is configured for being operatively actuated in a manner sufficient to deflect an array assembly and a backing element in substantially the same curvature when the array assembly and backing element are present in the device.

The Applicants' specification sets forth several figures wherein such a device including a base, a cover and a clamping member are illustrated as deflecting an array assembly and a backing element in substantially the same curvature when the array assembly and backing element are present in the device. See, for instance, Figures 5A to 6B. Additionally, the specification teaches embodiments that illustrate how a clamping member interacts with a base, cover and an included array assembly and a backing element to deflect the array assembly and backing element in the same curvature. See paragraphs 99 and 145.

Accordingly, in view of the amendments made herein, the Applicants contend there is no reason to believe one of skill in the art could not make and use the array assay device of Claim 1, the system of Claim 17 and the kit of Claim 31 from the disclosures set forth in the application without undue experimentation. Therefore, the Applicants contend that this rejection has been rendered moot, that the claims are fully enabled and respectfully request that the 35 U.S.C. § 112, first paragraph, rejection of Claims 1-19 and 31-33 be withdrawn.

***Claim Rejections – 35 U.S.C. § 112, second paragraph***

Claims 1-19 and 31-33 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-19 and 31-33 were rejected for allegedly omitting essential elements. The Office asserts that "an array assembly," a "backing element" and a "flexure" are essential elements of the claims and rejects Claims 1-19 and 31-33 for omitting these alleged essential elements.

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As stated above, Claims 1, 17 and 31 have been amended to clarify the claim language. Claims 1, 17 and 31 now recite that the clamping member is configured for being operatively actuated in a manner sufficient to deflect an array assembly and a backing element in substantially the same curvature when the array assembly and backing element are present in the device. The Applicants contend that in light of the above amendments, the claims recite all the essential elements of the claimed invention. The Applicants contend, therefore, that is rejection has been rendered moot and respectfully request that the rejection be withdrawn.

Claims 1, 17 and 31 were rejected for allegedly being unclear. The Office asserts that the language "wherein when said cover is operatively held to said base about a structure" is unclear.

As stated above, Claims 1, 17 and 31 have been amended to clarify the claim language. Claims 1, 17 and 31 no longer recite the language that was allegedly unclear. The Applicants contend that in light of the above amendments, the claim language is clear and distinct. The Applicants believe, therefore, that is rejection has been rendered moot and respectfully request that the rejection be withdrawn.

Claims 1, 17 and 31 were rejected for allegedly being unclear. The Office asserts that the term "structure" is unclear.

As stated above, Claims 1, 17 and 31 have been amended to clarify the claim language. Claims 1, 17 and 31 no longer recite the language that was allegedly unclear. The Applicants contend that in light of the above amendments, the claim language is clear and distinct. The Applicants believe, therefore, that is rejection has been rendered moot and respectfully request that the rejection be withdrawn.

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***Claim Rejections – 35 U.S.C. § 102(b)***

Claims 1-8, 14-19 and 31-33 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Freeman (USPN 5,958,760).

According to the MPEP, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Additionally, the identical invention must be shown in as complete detail as is contained in the claim. See MPEP 2131.

An element of the rejected claims as amended is a clamping member that is configured for being operatively actuated in a manner sufficient to deflect an array assembly and a backing element in substantially the same curvature when the array assembly and backing element are present in the device.

Nowhere does Freeman teach a device that includes a clamping member that is configured for being operatively actuated in a manner sufficient to deflect an array assembly and a backing element in substantially the same curvature. Freeman does not teach this element because Freeman is completely silent as to how the clamping member, when actuated, interacts with an array assembly and backing member. Because Freeman is silent in this regard, Freeman does not teach a clamping member that is configured for being operatively actuated in a manner sufficient to deflect an array assembly and a backing element in substantially the same curvature.

The Office, however, asserts that Freeman teaches that the force from the clamping member is dissipated over a greater area of the assembly. In support of this assertion the Office cites column 11, lines 55 to 65. However, the cited passage is reproduced below:

The outer end of the clamping member 124 is provided with a knurled knob to facilitate manual operation. The opposite end of the clamping member 124 is

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provided with, or contacts, a clamping plate 128. Clamping plate 128 serves to spread the clamping force of the clamping member 124 over a greater area of the support retaining member 116.

As can be seen with reference to the cited passage, the dissipation of the clamping force is caused by the interaction of the clamping member with the clamping plate. There is nothing in the cited passage that indicates that the clamping member is configured for being operatively actuated in a manner sufficient to deflect an array assembly and a backing element in substantially the same curvature.

Therefore, Freeman is deficient because it does not teach every element of the rejected claims, namely, a clamping member that is configured for being operatively actuated in a manner sufficient to deflect an array assembly and a backing element in substantially the same curvature. Because Freeman does not teach every element of the rejected claims it does not anticipate the claimed invention. Accordingly, in view of the above, the Applicants respectfully request that the 35 U.S.C. § 102(b) of Claims 1-8, 14-19 and 31-33 be withdrawn.

#### ***Claim Rejections – 35 U.S.C. § 103(a)***

Claims 9-13 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Freeman (USPN 5,958,760) in view of Shea (US Publication No 20030235906).

With respect to Claims 9-13, the Office acknowledges that Freeman is deficient because it does not teach a clamping member flexure. The Office, therefore, relies upon Shea to remedy the deficiencies of Freeman. However, Shea was filed June 21, 2002 and published December 25, 2003. The present application was filed December 5, 2003. Accordingly, Shea was filed before the filing of the present application but published after the December 5, 2003 priority date of the present application. Therefore, Shea can only constitute prior art under 35 U.S.C. §102 (e).

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For Shea to be available as prior art under § 102 (e), 35 U.S.C. § 103(c), MPEP § 706.02(l)(1) states:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102 (e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 C.F.R. 1.53(b), continued prosecution application filed under 37 C.F.R. 1.53(d), and reissues."

As such the changes to 35 U.S.C. §103 apply to all utility patent applications filed on or after November 29, 1999. The instant application was filed on December 5, 2003, which is after November 29, 1999. Accordingly, §103(c) as set out above applies to the instant application. Thus, if the Shea publication and the instant application were owned by the same person or subject to an obligation of assignment to the same person, at the time the instant application was made, the Shea publication is disqualified as prior art under 35 U.S.C. §102 (e) and therefore cannot preclude patentability under §103.

This is indeed the case. The invention claimed in the instant patent application was subject to an obligation of assignment to Agilent Technologies. An assignment executed by the inventor Allen C. Thompson was recorded in this case on March 20, 2006 (Reel/Frame 017334/0696) (copy enclosed).

The Shea publication cited as art was owned by Agilent Technologies at the time the claimed invention was made, as evidenced by an assignment by the listed inventors to Agilent Technologies, recorded on December 2, 2002 (Reel/Frame 013274/0656) (copy enclosed).

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As can be seen in view of these two assignments, the subject matter of the cited Shea publication and the presently claimed invention were, at the time the invention was made, both owned by Agilent or both under an obligation of assignment to Agilent. As such, in accordance with §103(c), the Shea publication shall not preclude patentability under §103.

Therefore, the Shea patent is not available as prior art against the claimed invention of the present application under §102 (e). The claims thus cannot be rejected under § 103 (a) by a combination that relies upon the disclosure of Shea.

Accordingly, the Applicants respectfully request the rejection of Claims 9-13, under 35 U.S.C. § 103 (a) as being obvious over Freeman in view of Shea be withdrawn.

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### CONCLUSION

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 833-7770.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10030636.

Respectfully submitted,

Date: May 12, 2006

By: 

James S. Nolan  
Registration No. 53,393

Date: May 12, 2006

By: 

Bret E. Field  
Registration No. 37,620

Enclosure(s):

- Assignment information for Serial No. 10/177,192
- Assignment information for Serial No. 10/729,606

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Intellectual Property Administration  
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## Patent Assignment Abstract of Title

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## Total Assignments: 1

Patent #: NONE

Issue Dt:

Application #: 10729606 Filing Dt: 12/05/2003

Publication #: US20050123931 Pub Dt: 06/09/2005

Inventors: Allen C. Thompson, George P. Tsai, Russell Alan Parker

Title: Devices and methods for performing array based assays

## Assignment: 1

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Recorded: 03/20/2006

Pages: 4

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

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Exec Dt: 12/04/2003

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## Patent Assignment Abstract of Title

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## Total Assignments: 1

Patent #: NONE

Issue Dt:

Application #: 10177192 Filing Dt: 06/21/2002

Publication #: US20030235906 Pub Dt: 12/25/2003

Inventors: Laurence R. Shea, Douglas G. Summers

Title: Devices and methods for performing array based assays

## Assignment: 1

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Pages: 3

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignors: SHEA, LAURENCE R.

Exec Dt: 10/28/2002

SUMMERS, DOUGLAS G.

Exec Dt: 10/22/2002

Assignee: AGILENT TECHNOLOGIES, INC.

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